REMARKS

Claims 10 and 11 are pending in this application. Reconsideration and withdrawal of the rejections of the application are requested in view of the amendments and remarks presented herein, which place the application into condition for allowance, or at least into better condition for appeal.

THE REJECTION UNDER 35 U.S.C. § 102 IS OVERCOME

Claims 11 and 12 were rejected under Section 102(b) as allegedly being anticipated by Lamph. The Office Action argues that the teachings of Lamph inherently encompass the claimed invention, which is directed to a method of producing neurite outgrowth using an RARβ2 agonist. The rejection is traversed.

Lamph does not teach each and every element/step of the claim. In addition, there can be no position based on inherency with respect to stimulating neurite outgrowth because the reference does not teach the step of contacting neuronal cells with an agonist of RARβ2.

The Examiner argues that the reference teaches that agonists of RARβ2 can be used in the treatment of "patients with Alzheimer's, Parkinson's or Lou Gehrig's disease, who possess neuronal cells that will be contacted by RA and other RARβ2 agonists that are indistinguishable from the instant methods and are encompassed by the instant claims."

To the contrary, the reference does not teach that agonists of RARβ2 can be used to treat patients with Alzheimer's, Parkinson's or Lou Gehrig's disease. The reference teaches that compounds identified by a screening method of the invention (i.e., a method of detecting the presence or amount of a compound capable of binding to a hRXR-γ polypeptide) can be used for the treatment of (a long list) of diseases including Alzheimer's, Parkinson's or Lou Gehrig's disease. There is no teaching or suggestion that an agonist of RARβ2 - or even a compound identified by the disclosed screening method involving hRXR-γ - is contacted with a neuronal cell. The claimed method requires the step of contacting a neuronal cell with an agonist of RARβ2. Without the teaching of this step in the reference, there can be no position based on inherency.

Simply because Alzheimer's, Parkinson's, and Lou Gehrig's diseases are listed in a laundry list of diseases of which unidentified compounds can potentially be used for treating afflicted patients, the artisan can not make the incredible leap that an agonist of RARβ2 will be contacted with a neuronal cell to thereby stimulate neurite outgrowth. In fact, the artisan would

not even consider that neurite outgrowth would be a therapeutic effect resulting from the treatment of any one of Alzheimer's, Parkinson's, or Lou Gehrig's diseases. To the contrary, one would expect that the effect of neurite outgrowth would have therapeutic relevancy in nervous system injuries such as spinal cord injuries, a condition not even remotely referenced in the laundry list of diseases referred to in pages 16-17 of the Lamph reference.

Accordingly, the 102 rejection based upon the Lamph reference is improper and reconsideration and withdrawal of the rejection are requested.

CONCLUSION

The application is in condition for allowance. Favorable reconsideration of the rejection and prompt issuance of a Notice of Allowance are earnestly solicited.

Respectfully submitted,

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